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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/816,091  | 03/26/2001  | Masashi Ota          | 109073              | 9597             |
| 25944   | 7590        | 10/09/2003           |                     |                  |
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| EXAMINER<br>CHERRY, STEPHEN J                                   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 2863  |             |                      |                     |                  |

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/816,091

Applicant(s)

OTA ET AL.

Examiner

Stephen J. Cherry

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

U.S. Patents 6,018,972 and 6,067,833 included in the Information Disclosure Statement filed 11-5-02, were previously considered, as noted in paper 5 of the application.

### ***Claim Objections***

Claims 6-12 are objected to because of the following informalities: Claim 6 recites "manufacturing a product using a plurality of manufacturing processes". This limitation does not appear to define a structure of the apparatus. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,734,719 to Tsevdos et al.

Claim 1 describes, as disclosed by Tsevdos ('719):

1. A method for monitoring the status of manufacturing products continuously according to one of a plurality of manufacturing processes, comprising:

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manufacturing a product using a plurality of manufacturing processes, ('719, col. 19, lines 27 to 45, steps co4 and co6)

determining if at least a predetermined manufacturing process, licensed by a license agreement, out of the plurality of manufacturing processes has been executed, ('719, col. 20, line 33)

storing the number of operations executed for manufacturing the products according to the predetermined manufacturing process, when it is determined that the predetermined manufacturing process has been executed; and ('719, fig. 31, "Count")

outputting the stored number of operations executed for manufacturing the products according to the predetermined manufacturing process. ('719, fig. 31, "Count")

Claim 2 describes, as disclosed by Tsevdos ('719):

2. The method of claim 1, wherein the determining step comprises:

executing a program for determining if the predetermined manufacturing process has been executed, together with the plurality of manufacturing processes, or independently therefrom, ('719, col. 19, line 55 to col. 20, line 4).

Claim 3 describes, as disclosed by Tsevdos ('719):

3. The method of claim 1, further comprising:

detecting operation of a device operated according to the predetermined manufacturing process; and outputting a predetermined signal, on the basis of which it is determined if

the predetermined manufacturing process has been executed. ('719, col. 16, line 52, "op\_make')

Claim 4 describes, as disclosed by Tsevdos ('719):

4. The method of claim 3, wherein the determining step comprises:

executing a program for determining if the predetermined manufacturing process has been executed, together with the plurality of manufacturing process, or independently therefrom, and ('719, col. 19, line 55 to col. 20, line 4)

wherein the storing step comprises:

storing the number of operations executed for manufacturing the products according to the predetermined manufacturing process, when the program for determining has determined that the predetermined manufacturing process has been executed, and determined that the predetermined manufacturing process has been executed on the basis of the output signal. ('719, col. 16, line 52, "op\_make", and fig. 31, "Count")

Claim 5 describes, as disclosed by Tsevdos ('719):

5. The method of claim 1, further comprising: transmitting the stored number of operations to a communication infrastructure. ('719, fig. 1, 118, network device through which data depicted in fig. 31 is transmitted).

Claim 6 describes, as disclosed by Tsevdos ('719):

6. An apparatus for monitoring the status of manufacturing products continuously according to one of a plurality of processes, comprising:  
manufacturing a product using a plurality of manufacturing processes, ('719, col. 19, lines 27 to 45, steps co4 and co6),  
determination means for determining if at least a predetermined manufacturing process licensed by a license agreement out of the plurality of manufacturing processes has been executed; ('719, 110)  
storage means for storing the number of operations executed for manufacturing the products according to the predetermined manufacturing process, when the determination means determines that the predetermined manufacturing process has been executed; and ('719, 108)  
output means for outputting the number of operations executed for manufacturing the products according to the predetermined manufacturing process stored in the storage means. ('719, 108, and fig. 31)

Claim 7 describes, as disclosed by Tsevdos ('719):

7. (Amended) The apparatus of claim 6, wherein the determination means comprises a program for determining if the predetermined manufacturing process has been executed, together with the plurality of manufacturing processes, or independently therefrom ('719,col. 19, line 55 to col. 20, line 4).

Claim 8 describes, as disclosed by Tsevdos ('719):

8. The apparatus of claim 6, further comprising: detection means for detecting operation of a device operated according to the predetermined manufacturing process, and outputting a predetermined signal, and wherein the determination means determines if the predetermined manufacturing process has been executed, on the basis of the signal output from the detection means. ('719, col. 16, line 52, "op\_make')

Claim 9 describes, as disclosed by Tsevdos ('719):

9. The apparatus of claim 8, wherein the determination means comprises a program for determining if the predetermined manufacturing process has been executed, together with the plurality of manufacturing processes, or independently therefrom ('719,col. 19, line 55 to col. 20, line 4), and wherein the storage means stores the number of operations executed for manufacturing the products according to the predetermined manufacturing process, when the determination means determines that the predetermined manufacturing process has been executed according to the determining program, and determines that the predetermined manufacturing process has been executed on the basis of the signal output from the detection means ('719, col. 16, line 52, "op\_make", and fig. 31, "Count").

Claim 10 describes, as disclosed by Tsevdos ('719):

10. The apparatus of claim 6 further comprising: communication means for transmitting the output of the output means to a communication infrastructure, to which the number of operations stored in the storage means is transmitted. ('719, fig. 1, 118)

Claim 11 describes, as disclosed by Tsevdos ('719):

11. (Amended) The apparatus of claim 6, wherein a license agreement is provided for a property covering the products or a process for manufacturing the products, under the license agreement, a licensee of the agreement holding the apparatus for monitoring the status of manufacturing the products , and wherein the monitoring apparatus determines if the product or the process made or used by the licensee is covered by the licensed property, on the basis of operation of the predetermined manufacturing process for manufacturing the products ('719, col. 18, line 11)

Claim 12 describes, as disclosed by Tsevdos ('719):

12. The apparatus of claim 11, wherein the property to be licensed under the license agreement is at least one of a utility patent, design patent, know how, copy right ('719, col. 4, line 10), and technical assistance.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 5,418,713 to Allen.




Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen J. Cherry whose telephone number is (703) 305-0425. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (703) 308-3126. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0719.

SJC



John Barlow  
Supervisory Patent Examiner  
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